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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/392,028	09/08/1999	William D. Smith II	RD-27419	9474

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JOHN S BEULICK
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE SUITE 2600
ST LOUIS, MO 631022740

EXAMINER

FELTEN, DANIEL S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 05/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/392,028

Applicant(s)
Smith et al

Examiner
Daniel Felten

Art Unit
3624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 18, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

1
2 1. Receipt of the Request for Reconsideration filed January 18, 2002 is acknowledged.

3
4 *Response to Arguments*

5 2. Applicant's arguments filed January 18, 2002 have been fully considered but they are
6 not persuasive.

7 References, in determining obviousness are not read in isolation by what they fairly
8 teach in combination with prior art *as a whole*, and thus patent assignee's reference-by-
9 reference attack on prior art to demonstrate non-obviousness is not persuasive (Photo sensing
10 system) Banner Engineering v. Tri-Tronics Co. Inc., 29 USPQ 1392 1389 (CAFC 1993
11 unpub) citing in re Merck, 231 USPQ 375 (CAFC 1986).

12 References are evaluated by what they suggest to one versed in the art, rather than their
13 specific disclosure [see In re Bozek, 163 USPQ 545 (CCPA 1969)]. In this case, the primary
14 reference discloses a method for processing financial information process management and
15 workflow system coupled to a data repository, the secondary reference discloses a method for
16 processing a cash advance request via a financial transaction card. The 35 U. S.C. 103
17 rejection set forth above provides reasoning for combinations of references and resolve the
18 level of ordinary skill in the business method art.

1 In response to the applicant piecemeal analysis of the references, the examiner
2 respectfully submits that one cannot show non-obviousness by attacking references individually
3 where, as here, the rejections are based upon a combination of references.

4 In response to applicant's argument that there is not suggestion to combine references,
5 the Examiner recognizes references cannot be arbitrarily combined and that there must be some
6 reason why one skilled in the art would be motivated to make the proposed combination of
7 primary references and secondary references [see In re Nomija, 184 USPQ 607 (CCPA 1975)].
8 However, there is no requirement that a motivation to make the modification be expressly
9 articulated. The test for combining references is what the combination of disclosures taken as
10 a whole would suggest to one of ordinary skill in the art [see In re McLaughlin, 170 USPQ
11 209 (CCPA 1971)].

12
13
14 ***Conclusion***

15
16 3. Any inquiry concerning this communication or earlier communications from the examiner
17 should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The
18 examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday.
19 Any inquiry of a general nature relating to the status of this application or its proceedings should
20 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor
21 ***Vincent Millin*** whose telephone number is (703) 308-1065.

1
2 4. Response to this action should be mailed to:
3


4 Commissioner of Patents and Trademarks

5 Washington, D.C. 20231
6

7 for formal communications intended for entry, or (703) 305-0040, for informal or draft
8 communications, please label "Proposed" or "Draft".

9 Communications via Internet e-mail regarding this application, other than those under 35
10 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
11 addressed to *[daniel.felten@uspto.gov]*.
12

13 All Internet e-mail communications will be made of record in the application file. PTO
14 employees do not engage in Internet communications where there exists a possibility that
15 sensitive information could be identified or exchanged unless the record includes a properly
16 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
17 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
18 Trademark on February 25, 1997 at 1 195 OG 89.
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20

21 
22 DSF
23 May 6, 2002


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100
